

REMARKS

Claims 1, 3-4, 7-9, 11-12 and 15-20 are pending. Claims 1 and 9 have been amended to recite that X and X' are calcium, m is 1 and n is 2. Claims 4 and 12 have been amended to recite that Y is NR₁, R₁ is hydroxypropyl and R₂ is methyl. Claims 2, 5, 6, 10, 13, 14 and 21-46 have been canceled without prejudice to their being asserted in any future continuation, continuation-in-part or divisional application.

35 U.S.C. § 103

The Examiner has rejected claims 1-3, 7-11 and 16-19 as obvious over WO 89/00052 (Vanderipe) in view of U.S. Patent No. 4,016,290 (Rahman) because it would have allegedly been obvious to modify Vanderipe using the teachings of Rahman to create an excipient product wherein X and X' are calcium, L' is DTPA, and both m and n are 1 and the create an excipient product wherein X and X' are calcium, L' is DTPA, both m and n are 1 and the metal is gadolinium(III) and the organic ligand is DTPA. Applicants note that the Examiner has stated that the claims are allowable over the prior art for the elected species, namely - m=1, n=2, X = calcium, X' = calcium, R₁ = hydroxypropyl, R₂ = methyl and Y = NR₁. Applicants respectfully traverse the Examiner's § 103 rejection and reserve the right to pursue the rejected species in any future continuation, continuation-in-part or divisional application.

However, solely to expedite prosecution, applicants have hereinabove amended independent claims 1 and 9, and their respective dependent claims 4 and 12, to recite only the elected species. Thus applicants respectfully assert that the Examiner's § 103 rejection is moot and withdrawal of this rejection is respectfully requested.

35 U.S.C. § 112 ¶ 2

The Examiner has rejected claims 1-4, 7 and 8 as indefinite because some of the limitations of the metal chelate M(L) have been allegedly incorporated into the variables of the excipient. The Examiner then states that “a recitation of intended use carries patentable weight in a method, not product claim.” Applicants respectfully traverse the Examiner’s § 112 ¶ 2 rejection.

As the Examiner notes, the product of claim 1 has the formula $X_m[X'(L')_n]$. Applicants respectfully note that claim 1 reads in relevant part “L’ is an organic ligand which may be L or another organic ligand which has a greater affinity for M than for calcium or zinc.” Thus, L’, which is part of the excipient, can have the same structure as L, as described in the specification, or it can be an “another organic ligand with greater affinity for M than for calcium or zinc.” See Spec. at pp. 2:21-3:12. Applicants do not define L’ in terms of intended use, but instead in terms of its properties, *e.g.* its structure (being the same as L) and its greater affinity for M than for calcium or zinc. Applicants respectfully maintain that it is proper to claim a product in terms of its structure and properties. Thus, for the above reasons, applicants respectfully request the withdrawal of the Examiner’s § 112 ¶ 2 rejection.

Therefore, for the above reasons, applicants respectfully assert that independent claim 1 and its directly and indirectly dependent claims 2-4 and 7-8, as well as independent claim 9 and its directly and indirectly dependent claims 11-12 and 15-20, are in condition for allowance. Thus allowance of claims 1, 3-4, 7-9, 11-12 and 15-20 is respectfully solicited.

CONCLUSION

No fees are believed due in connection with the filing of this *Amendment and Response*. However, the Director is hereby authorized to charge any required fees and credit any overpayments to Deposit Account No. 50-0540.

Respectfully submitted,

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